

REMARKS

Claims 1-3, 5-24, 26-58, and 60-83 were pending as of the action of June 30, 2010. Claims 1, 34, 65, and 76 are in independent form. Amendments to claims 1, 3, 5-11, 14, 16-21, 21, 27-34, 36-53, 56, 58, 60-65, 67, 71-76, and 78-83 are being submitted. Claims 2, 35, 66, and 77 are being canceled. No new matter has been added. Support for the amendments can be found throughout the specification, for example, in paragraphs 24, 42-43, and FIG. 9.

Reconsideration of the action is respectfully requested in light of the foregoing amendments and the following remarks.

Priority

The Examiner stated that claims 1-83 were not entitled to the priority date of prior provisional application no. 60/516,281 because “[m]orphing is not disclosed.”

While the word “morphing” does not appear in the prior provisional application, Applicant respectfully disagrees that the claims are not entitled to the benefit of its priority date. “The disclosure as originally filed does not have to provide *in haec verba* [“in these words”] support for the claimed subject matter at issue.” *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000).

Nevertheless, in order to expedite prosecution and without agreeing with the Examiner’s characterization of priority, Applicant has amended the claims to recite an “expandable advertisement,” which is described in the provisional application at, for example, page 4, line 17.

Applicant respectfully requests that the benefit of the filing date of priority application 60/516,281 be acknowledged.

Section 101 Rejections

Claims 76-83 were rejected under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter.

In order to expedite prosecution and without agreeing with the rejection, claims 76-83 have been amended to recite a “processor-readable storage device.”

Applicant respectfully requests that this rejection to claims 76-83 be withdrawn.

Section 112 Rejections

Claims 38-39, 44-55, and 61-64 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for mixing statutory classes.

In order to expedite prosecution and without agreeing with the rejection, these claims have been amended. Applicant respectfully requests that this rejection be withdrawn.

Claims 35-44, 50-54, 58, and 60 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

In order to expedite prosecution and without agreeing with the rejection, these claims have been amended. Applicant respectfully requests that this rejection be withdrawn.

Claims 45-49 and 56-57 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

In order to expedite prosecution and without agreeing with the rejection, these claims have been amended. Applicant respectfully requests that this rejection be withdrawn.

Section 103 Rejections

Petropoulos Reference

Claims 1-3, 5-12, 26, 28, 34-43, 56, 58, 60, 65-71, 73-74, 76-80, and 82-83 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2003/0146939 ("Petropoulos") in view of Official Notice. Applicant respectfully traverses this rejection.

Claim 1

Claim 1 as amended recites:

generating, at a server, an expandable advertisement comprising:
a compact display format including an associated expansion icon and a link to a landing page,
an expanded display format comprising the link to the landing page, a content portion, one or more content items, and one or more menu options associated with one or more respective content items, where each menu option, in response to a user selection, displays the one or more associated content items in the content portion, and code that enables a client device to transition between the expanded display format and the compact display format upon a user request;
receiving a request for one or more advertisements related to a subject matter of interest to be presented with content associated with a publisher; and
delivering in a single transmission, from the server to a client device, the expandable advertisement in response to the request to be presented with the content associated with the publisher.

Applicant respectfully submits that the relied upon portions of Petropoulos in view of Official Notice do not describe these features of claim 1.

The relied upon portions of Petropoulos describe a search engine with preview functionality. *See Abstract*. When search results are returned in response to a search query, a preview of a search result can be shown by a user mousing over the search result or selecting an icon. *See paragraph 23*.

The relied upon portions of Petropoulos do not describe, however, generating, at a server, an expandable advertisement comprising a compact display format including an associated expansion icon and a link to a landing page, an expanded display format comprising the link to the landing page, a content portion, one or more content items, and one or more menu options.

In contrast, the relied upon portions of Petropoulos describe a system where the target page of the search result is always shown in the preview window. Applicant respectfully asserts that while a landing page may itself include one or more links, those links would not be the same link as the link that is included in a web page search result (i.e., a landing page would not include a link to itself). Further, the relied upon portions of Petropoulos do not describe or suggest one or more menu options associated with one or more respective content items, where each menu option, in response to a user selection, displays the one or more associated content items in the content portion.

The relied upon Official Notice fails to remedy the above deficiencies of Petropoulos. In the Office Action, the Examiner took Official Notice "that advertiser interfaces enabling advertisers to input and/or modify/edit various advertisement data used for publication on publishers webpages are old and well-known at the time of the invention." *See* Office Action p. 10.

The relied upon Official Notice does not disclose, however, generating, at a server, an expandable advertisement comprising a compact display format including an associated expansion icon and a link to a landing page, an expanded display format comprising the link to the landing page, a content portion, one or more content items, and one or more menu options.

Accordingly, claim 1 is not obvious in view of the proposed combination of Petropoulos and Official Notice. Applicant respectfully submits that claim 1 is in condition for allowance. Claims 3, 5-24, and 26-33 depend from claim 1 and are allowable for at least this reason.

Claim 34

Claim 34 as amended is directed to an apparatus comprising a server to perform operations comprising:

generating an expandable advertisement comprising:

a compact display format including an associated expansion icon and a link to a landing page,

an expanded display format comprising the link to the landing page, a content portion, one or more content items, and one or more menu options associated with one or more respective content items, where each menu option, in response to a user selection, displays the one or more associated content items in the content portion, and code that enables a client device to transition between the expanded

display format and the compact display format upon a user request;
receiving a request for one or more advertisements related to a subject matter of interest to be presented with content associated with a publisher; and
delivering in a single transmission to a client device the expandable advertisement in response to the request to be presented with the content associated with the publisher.

Applicant respectfully submits that the relied upon portions of Petropoulos do not describe or suggest these features of amended claim 34. For at least the same reasons as set forth above with respect to claim 1, Applicant respectfully submits that claim 34 is in condition for allowance. Claims 35-58 and 60-64 depend from claim 34 and are allowable for at least this reason.

Claim 65

Claim 65 as amended is directed to a computer-implemented method comprising:

generating at a server, an expandable advertisement comprising:
a compact display format including an associated expansion icon and a link to a landing page,
an expanded display format comprising the link to the landing page, a content portion, one or more content items, and one or more menu options associated with one or more respective content items, where each menu options, in response to a user selection, displays the one or more associated content items in the content portion, and
code that enables a client device to transition between the compact display format and the expanded display format upon a user request;
including the expandable advertisement in an electronic document, the expandable advertisement including the compact display format, the expanded display format, the code, and instructions for initially displaying the expandable advertisement in the electronic document in the compact display format; and
delivering in a single transmission, from the server to the client device, the electronic document including the expandable advertisement.

Applicant respectfully submits that the relied upon portions of Petropoulos do not describe or suggest these features of amended claim 34. For at least the same reasons as set forth above with respect to claim 1, Applicant respectfully submits that claim 65 is in condition for allowance. Claims 67-75 depend from claim 65 are allowable for at least this reason.

Claim 76

Claim 76 as amended is directed to a processor-readable storage device storing instructions that cause a processor to perform operations comprising:

generating at a server, an expandable advertisement comprising:
a compact display format including an associated expansion icon and a link to a landing page,
an expanded display format comprising the link to the landing page, a content portion, one or more content items, and one or more menu options associated with one or more respective content items, where each menu option, in response to a user selection, displays the one or more associated content items in the content portion, and code that enables a client device to transition between the compact display format and the expanded display format upon a user request;
including the expandable advertisement in an electronic document, the expandable advertisement including the compact display format, the expanded display format, the code, and instructions for initially displaying the electronic document in the compact display format; and
delivering, in a single transmission, from the server to the client device, the electronic document including the expandable advertisement.

Applicant respectfully submits that the relied upon portions of Petropoulos do not describe or suggest these features of amended claim 34. For at least the same reasons as set forth above with respect to claim 1, Applicant respectfully submits that claim 76 is in condition for allowance. Claims 78-83 depend from claim 76 and are allowable for at least this reason.

Talegon Reference

Claims 29-32 and 61-63 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2003/0146939 ("Petropoulos") in view of U.S. Patent Publication No. 2003/0135460 ("Talegon"). Applicant respectfully traverses this rejection.

Claim 29 as amended recites:

storing a price parameter value in association with the one or more advertisements when one of the advertisements meets one or more performance parameters;
upon receiving a request for an advertisement, determining one or more advertisements to deliver based at least in part on the price parameter associated with a plurality of advertisements associated with the subject matter of interest; and
wherein the step of determining includes assessing whether to deliver the expandable advertisement based on the price parameter of the expandable advertisement, the price parameter value of at least one other advertisement and at least one area-based parameter.

The Examiner stated that Talegon describes "assessing whether to deliver the expandable advertisement based on the price parameter of the expandable advertisement, the price parameter

value of at least one other advertisement and at least one area-based parameter" at paragraphs 39 and 45. "Thus Talegon teaches the ad price is directly proportional to the ad space covered by the ad i.e. proportional to the real estate used by the ad." *See* Office Action p. 18. Applicant respectfully disagrees.

The relied upon portions of Talegon describe a system "for valuing and placing advertising segments on the basis of competitive bidding." *See Abstract*. The higher the bid amount, "the higher the *frequency* . . . that the advertiser's banner ad will be displayed on a banner ad rotation on the publisher's web site." *See* paragraph 39 (emphasis added).

Applicant respectfully submits that the relied upon portions of Talegon do not describe or suggest assessing whether to deliver the expandable advertisement based on the price parameter of the expandable advertisement, the price parameter value of at least one other advertisement and at least one area-based parameter as recited by amended claim 29. Instead, the ads in the relied upon portions of Talegon compete for frequency. "Thus, X Company, having placed the highest bid is ranked #1, and will receive the highest frequency of its banner ads being displayed on the publisher's site." *See* paragraph 40.

Applicant respectfully submits that claim 29 is in condition for allowance. Claims 30-32 depend from claim 29 and are allowable for at least this reason.

Claim 61 describes a system to perform operations including determining an "assessment whether to deliver an expandable advertisement based on the price parameter value of the expandable advertisement and an area-based parameter." Applicant respectfully submits that the relied upon portions of Talegon do not describe or suggest these features of claim 61 for at least the same reasons as set forth above with respect to claim 29.

Applicant respectfully submits that claim 61 is in condition for allowance. Claims 62-63 depend from claim 61 and are allowable for at least this reason.

Interview Summary

Applicant thanks Examiner Le for the courtesy of a telephonic and in-person interview with Applicant's undersigned representative and Mark D. Kirkland on Sept. 22, 2010. The rejection of claim 1 under 35 U.S.C. §103(a) was discussed in reference to the Petropoulos reference.

Applicant agreed to amend claim 1 to specify that both the compact and expanded format have a link to the same landing page. No other agreement was reached. Examiner Le indicated that the agreed upon amendments would help to advance prosecution, but that further search and consideration would be required.

Conclusion

For the foregoing reasons, Applicant submits that all the claims are in condition for allowance.

By responding in the foregoing remarks only to particular positions taken by the Examiner, Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, Applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, Applicant's decision to amend or cancel any claim should not be understood as implying that Applicant agrees with any positions taken by the Examiner with respect to that claim or other claims.

The required fees are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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